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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/632,279

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Mikio Uchida

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10/02/2006

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EXAMINER

CHANNAVAJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/632,279	<b>Applicant(s)</b> UCHIDA ET AL.	
	<b>Examiner</b> Lakshmi S. Channavajjala	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 9-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 9-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Receipt of amendment and response dated 7-24-06 is acknowledged.

Claims 1, 2, 4-5 and 9-23 are pending.

The following rejection of record has been maintained:

#### ***Claim Rejections - 35 USC § 103***

1. Claims 1, 2, 4-5 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US2002/0051798 to Koike et al ('798) in view of in view of EP 027 730 (EP 730).

'798 teach a gomme composition that generates heat upon contact with water and gives the user an excellent feeling to the user, comprising a component that generates heat upon contact with water such as magnesium chloride, calcium chloride, magnesium sulfate etc (0020); a substance that is liquid at 25 degrees C (other than water) (0017) comprising polyethylene glycol, lower alcohols, glycerol or oils; non-aqueous solvents (0018); and other surfactants. The composition of '798 is free of water (0019) and thus reads on the instant "anhydrous" composition. Table 3 and 4 of '798 teach in addition to the above components, behenyl alcohol, cellulose and polyoxyethylene castor oil, which read on the instant claimed, fatty alcohols, cellulose derivatives and polyoxyalkylene derivatives respectively. '798 discussed in the above paragraphs, fails to specify the claimed micron sizes of the inorganic heat-generating agent. However, absent evidence to the criticality of the particle size,

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it would have been within the scope of a skilled artisan to use appropriate particle size of the heat generating salts without affecting the warm feeling achieved by the composition.

'798 fail to teach the specific polyoxyalkylene derivatives of claims 1.

EP '730 teaches cosmetic compositions for hair or skin treatment, comprising heat generating compounds when brought into contact with water (page 3). Among the heat generating compounds EP 730 teaches fatty alcohols, alkylene glycols and polyoxyalkylene derivatives (page 5, in particular lines 8-19 and page 6, lines 8 to page 7, lines 13). More specifically EP 730 teaches the claimed polyoxyethylene and polyoxypropylene copolymer (example 4 on page 12). Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to use the pluronic or any other suitable polyoxyalkylene derivatives as heat generating agents in the composition of '798 because EP 730 teaches that the above polyoxyalkylene derivatives are preferable as heat generating compounds (page 8) and suggests that the heat generating compounds give an excellent finishing and cleansing effect to the consumer upon application, which results in a comfortable hot feeling. One of an ordinary skill in the art would have expected at least a synergistic effect with a combination of the heat generating salts of '798 and the polyoxyethylene and polyoxypropylene copolymer of EP 730.

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2. Claims 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US2002/0051798 to Koike et al ('798) in view of EP 027 730 (EP 730) as applied to claims 1, 2, 4-5 and 9-16, and further in view of US 6,540,989 to Janchitraponvej ('989).

Claims 20-22 require an amidoamines and an acid.

'798 and EP 730 fail to teach the claimed amidoamines.

'989 teach a self-warming hair care composition comprising a glycol, a quaternary ammonium compound, an amidoamines and a silicone. The composition of '989 is anhydrous and upon contact with water generates heat giving the user a pleasant feeling and also the conditioning ability (col. 1). '989 teach amidoamines (col. 3, lines 41-55; col. 5) and fatty alcohols (col. 4, lines 26-30; col. 5) that are also described in the instant specification. '989 also teach polyoxyalkylene derivatives. Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to add amido amine of '989 to the composition of '798, containing block polyoxyalkylene polymer and use the composition for hair care such as hair conditioning because '989 teaches that a heat generating composition that is self-warming gives a warm feeling to use and also provides good conditioning because of the presence of amido amine that acts as a deposition aid and a conditioner. Accordingly, the expected result would be to effectively condition hair as well as provide a warmth sensation to use indicating that the composition is working effectively. Further, with respect to the ratio of amidoamines and acid claimed, '989 teach that a clear conditioning composition is obtained with amino acid neutralized with acid. Accordingly,

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optimizing the ratio of amido amine and acid so as to obtain an effective conditioning effect.

### ***Response to Arguments***

Applicant's arguments filed 7-24-06 have been fully considered but they are not persuasive.

#### **Claims 1, 2, 4, 5 and 9-16**

Applicants argue that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify or to combine the reference teachings. It is argued that '798 teach that the cosmetic may comprise a component a heat generating component like magnesium sulfate, but fails to teach the claimed polyoxyalkylene derivative, in particular the claimed amounts of polyoxyethylene/polyoxypropylene block copolymer.

It is argued that while EP '730 teaches the use of polyoxyalkylene derivatives in an amount of 50%-95% by weight based on the total weight of the composition and teaches away from using less than 50% for satisfactory heat generating effect. Applicants argue that instant claimed 0.1% to 10% of the above polymer is neither taught nor suggested by EP. However, applicants' arguments are not persuasive because instant claims merely recite 0.1% -10% but do not recite if the amount of the polymer is based on the total weight of the composition. The idea of combining the teachings of EP 730 and '798 flows logically since '798 and 'EP 730 teach a separate compound for the same effect i.e., heat generation upon contact with water. In re Kerkhoven, 626 F.2d 846,

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850, 205 USPQ 1069, 1072 (CCPA 1980). Further, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In this regard, applicants state on page 6 of the instant specification application describe that the polymer can be used at a level as high as 90%. Therefore, absent evidence to the criticality of the claimed percentages of polyoxyethylene/ polyoxypropylene block copolymer, optimizing the amounts of individual compounds providing the same effect (result-effective variables) i.e., inorganic heat generating agents of '798 as well as polyoxyethylene/ polyoxypropylene block copolymer of EP '730, both taught for heat generating effect would have been obvious to one of an ordinary skill in the art.

#### Claims 17-23

Applicants argue that there is no requisite motivation to combine or modify the teachings of '798 with that of EP '730, to arrive at the composition of claims 1, 2, 4-5 and 9-16 and accordingly the claims 17-23 dependent from the above claims do not are not obvious over the cited prior art. Applicants arguments regarding the teachings of EP '730 and US '798 have been addressed and for the reasons mentioned above. Further, '989 further teach amidoamines for the

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same purpose. Thus, all the references cited constitute analogous art and therefore, as explained the combination renders instant claims obvious and the expected result by a skilled artisan is at least effect in producing the desired heat and imparting the warm feeling to the user, to skin as well as hair.

Examiner notes that claim 4 is made dependent upon claim 3, which appears to be a typographical error and correction is requested.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone



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number is 571-272-0591. The examiner can normally be reached on 7.00 AM to 4.30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lakshmi S Channavajjala  
Primary Examiner  
Art Unit 1615  
September 27, 2006